REMARKS

Rejections under 35 U.S.C. §§ 102(e) and 103(a)

Claims 1, 2, 6 and 10 stand rejected under 35 U.S.C. § 102(e) as allegedly being anticipated by Fujii et al. (U.S. Patent Application Publication No. 2005/0272223) (hereinafter "Fujii"). Claims 3-5 and 7-9 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Fujii in view of Fukuyo et al. (U.S. Patent Application Publication No. 2004/0002199) (hereinafter "Fukuyo"). The rejections in the Office Action are respectfully traversed for at least the following reasons.

Applicants respectfully submit that Fujii does not have a 35 U.S.C. § 102(e) date because it's corresponding WIPO publication (WO 03/077295) did not publish in the English language. As a result, Fujii was not properly applied in the rejections under 35 U.S.C. §§ 102(e) and 103(a) at least for this reason. Nevertheless, as the corresponding WIPO publication (WO 03/077295) has a publication date of September 18, 2003, that WIPO publication might be applied by the Examiner under some other section of 35 U.S.C. § 102. As a result, Applicants provide the following technical traversal of the rejections under 35 U.S.C. §§ 102(e) and 103(a).

Applicants respectfully submit that independent claim 1 of the instant application describes an advantageous combination of features of a laser processing method that includes forming a first modified region along a first line to cut for cutting the substrate and laminate part into a plurality of blocks. The claim also includes features of wherein the first modified region is more likely to cause the substrate to fracture than is the second modified region. The claim also includes features of forming a second modified region along a second line to cut for cutting blocks into a plurality of chips, each chip including at least one of the functional devices.

Applicants note that, as a result of these advantageous features, when an expandable tape (expandable film) is attached to the rear face of the substrate and expanded, for example, the substrate and laminate part begin to be cut into blocks from the first modified region acting as a starting point. Then, the blocks begin to be cut into chips from the second modified region acting as a starting point. Applicants respectfully submit that when the cutting starts stepwise from a larger block into smaller chips as such, uniform tensile stresses act on parts extending along the first and second lines to cut, whereby the laminate part can be cut with high precision together with the substrate along the first and second lines to be cut. On the contrary, Applicants respectfully submit that Fujii does not disclose these advantageous technical features to any extent.

Applicants are intimately familiar with the disclosure of Fujii because it is assigned to the same Assignee as the instant application. In addition, after careful study of the Examiner's rejections, Applicants respectfully submit that the portions of Fujii cited in the Office Action, namely Figs. 16 and 17, and paragraphs 127, 128 and 131 for claim 1, as well as Figs. 19 and 21, and paragraphs 127, 128 and 131 for claim 2 are irrelevant to the features described in these claims. Applicants notes that it appears that the rejections in the Office Action were based on a technical misunderstanding of the features described in the claims of the instant application. Applicants thus hope that these instant remarks will help to clarify these advantageous features of the instant application.

Independent claim 10 includes similar features as discussed above with regard to independent claim 1 of the instant application. As a result, Applicants respectfully submit that

similar arguments, as discussed above with regard to independent claim 1 of the instant application, also apply to independent claim 10 of the instant application.

Accordingly, Applicants respectfully assert that the rejections under 35 U.S.C. §§ 102(e) and 103(a) should be withdrawn because Fujii does not teach or suggest each feature of claims 1 and 10 of the instant application. As pointed out in MPEP § 2131, "[t]o anticipate a claim, the reference must teach every element of the claim." Thus, "[a] claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference. Verdegaal Bros. v. Union Oil Co. Of California, 2 USPQ 2d 1051, 1053 (Fed. Cir. 1987)." Similarly, MPEP § 2143.03 instructs that "'[a]ll words in a claim must be considered in judging the patentability of that claim against the prior art.' In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970)."

The dependent claims are in condition for allowance at least because of their dependence from independent claim 1. Also, with regard to dependent claims 3-5 and 7-9, the additionally applied reference to Fukuyo does not cure the deficiencies discussed above with regard to Fujii.

CONCLUSION

In view of the foregoing, Applicants submit that the pending claims are in condition for allowance, and respectfully request reconsideration and timely allowance of the pending claims. Should the Examiner feel that there are any issues outstanding after consideration of this response, the Examiner is invited to contact Applicants' undersigned representative to expedite prosecution. A favorable action is awaited.

EXCEPT for issue fees payable under 37 C.F.R. § 1.18, the Commissioner is hereby authorized by this paper to charge any additional fees during the entire pendency of this application including fees due under 37 C.F.R. § 1.16 and 1.17 which may be required, including any required extension of time fees, or credit any overpayment to Deposit Account No. 50-0573. This paragraph is intended to be a **CONSTRUCTIVE PETITION FOR EXTENSION OF TIME** in accordance with 37 C.F.R. § 1.136(a)(3).

Respectfully submitted,

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